

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q106386

Pascal CHARROPPIN

Appln. No.: 10/767,143

Group Art Unit: 3628

Confirmation No.: 4295

Examiner: Shannon S. SALIARD

Filed: January 29, 2004

For: DEVICE ALERTING TO EXPIRATION IN A FRANKING SYSTEM

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The statutory fee of \$540.00 is being remitted. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,

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Date: December 8, 2010

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is Neopost Industrie (assignee), of Bagneux, France, by virtue of an assignment executed by Pascal Charroppin of Le Vesinet, France. The assignment was previously submitted and was recorded on June 25, 2004, at Reel 015496, Frame 0697.

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of the Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences (“Board”) that will directly affect or be affected by the Board’s decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-10 are all the claims pending in the application.

Claims 11 and 12 have been canceled.

Claims 1-10 stand rejected and are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

An Amendment under 37 C.F.R. § 1.116 was filed on July 27, 2010. The Amendment amended independent claims 1 and 5. An Advisory Action dated August 25, 2010 indicated that the Amendment has been entered for purposes of appeal. Accordingly, these amendments are reflected in the appended claims.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The features of independent claims 1 and 5 will be referred to with respect to the non-limiting exemplary embodiments. Portions of the specification and drawings referred to should be considered as illustrative of the exemplary embodiments and not as being limiting in any manner.

The invention generally relates to a franking system which alerts a user when a postal tariff of a tariff table is out of date, and allows the user to decide whether to use a new (updated) tariff or to use the current tariff even though it is out of date. As such, the user has control over whether an old tariff or new tariff is applied, instead of the new tariffs automatically replacing the old tariffs.

Claim 1

Independent claim 1 recites: a device alerting to the expiration of tariffs for a franking system, comprising:

a random access memory (RAM) (page 4, lines 5-7; FIG. 2, element 220) for recording postal data including:

a first table of postal tariffs relative to postal products and services, said first table of tariffs comprising postal tariffs applicable before a date of application (page 4, lines 12-17; FIG. 2, element 230),

a second table of postal tariffs relative to postal products and services, said second table of tariffs comprising postal tariffs applicable after said date of application (page 4, lines 24-26; page 5, lines 12-19; FIG. 2, element 250); and

a processing unit comprising comparing means for comparing one by one postal data in said first table of postal tariffs with corresponding postal data in said second table of postal tariffs (page 5, lines 6-10; FIG. 2, element 200),

wherein said processing unit further comprises:

means for emitting to the operator of the franking system a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed (page 6, lines 11-20; FIG. 3, elements 28, 30, 32), and

means for receiving a decision of the operator whether to replace the postal tariffs of the first table with the postal tariffs of the second table, for updating the postal tariffs at the operator's request (page 6, line 24 to page 7, line 5; FIG. 3, element 34),

the device further comprising a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date (page 3, lines 16-18; page 7, lines 1-5; FIG. 3, element 34).

Claim 5

Independent claim 5 recites a process for alerting to the expiration of tariffs for a franking system comprising a display, a keyboard, a random access memory (RAM) for recording postal data and a processing unit for updating these postal data, said process comprising the following steps:

at a time of franking, when a date of application of new postal data previously loaded in the RAM of the franking system is identical to or earlier than a franking date of a mail item to be franked desired by an operator of the franking system (FIG. 3, element 22, decision “YES”),

comparing by the processing unit of the franking system current postal data of the mail item to be franked and present in the RAM one by one with corresponding new postal data to determine whether there is a change in the current postal data (page 5, lines 6-10; FIG. 3, element 28);

when it has been determined that the current postal data has changed, displaying a message on the display of the franking system alerting the operator to the expiration of tariffs (page 6, lines 11-20; FIG. 3, element 30, 32);

receiving on the keyboard a decision of the operator whether to replace the current postal data with the new postal data (page 3, lines 25-27; page 6, line 24 to page 7, line 5); and

when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date (page 7, lines 3-5).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Independent claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum et al. (US 7,103,583; hereinafter “Baum”) in view of Boothby (US 5,684,990) and Dlugos et al. (US 6,463,133; hereinafter “Dlugos”), and further in view of Official Notice.
2. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos, and Official Notice, and further in view of Eckert (US 4,516,014).
3. Claims 1-3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos.
4. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos and further in view of Thiel (US 6,321,214).

VII. ARGUMENT

1. Independent claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum et al. (US 7,103,583; hereinafter “Baum”) in view of Boothby (US 5,684,990) and Dlugos et al. (US 6,463,133; hereinafter “Dlugos”), and further in view of Official Notice.

Applicants respectfully submit that, for at least the following reasons, the combined teachings of Baum, Boothby, Dlugos, and the Official Notice do not disclose all of the features of the claimed combination of independent claim 5, in which the mail item is franked with current postal data even though the date of application of the current postal data is out of date.

The present invention allows the user to decide whether to use a new (updated) tariff or to use the current tariff even though it is out of date.

Specifically, independent claim 5 recites, *inter alia*, “when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date.”

The Examiner concedes that Baum does not disclose means for receiving a decision of the operator whether to replace the postal tariffs, for updating them at the operator’s request. To overcome this deficiency of Baum, the Examiner turns to Dlugos as allegedly teaching this feature (Final Office Action dated April 28, 2010, page 12). The Examiner also takes Official Notice that it is known to continue to operate a franking machine with current postal data when it is determined that the postal data has not changed (Final Office Action dated April 28, 2010, page 13). Applicants respectfully disagree for the reasons which follow.

As disclosed by Dlugos, when tariffs are out of date, and new tariffs are available, the new tariffs automatically replace the old tariffs. The Examiner's position is not at all true if the date of the application of the subject current data is out of date. On the contrary, the cited art teaches replacing the old table of tariffs with a new table of tariffs when the date of application of the old tariffs is out of date (see e.g., Dlugos). For example, Dlugos discloses that the Central Office informs the meter that the postal rates are changing and that the postal table of tariffs will require modification. Then the user must insert a module on a socket of the meter (column 4, lines 55-59). If a module is not inserted, the meter is out of service (column 5, line 2). On the other hand, if the module is present, a data communication is established between the Central Office and the meter, and the new rates are downloaded in the module (column 5, lines 15 and 37-40). Thus, the new tariffs all replace the old tariffs, and consequently, the old tariffs cannot be used after receiving this information from the central office. That is, in Dlugos, the tariffs are automatically updated and the user has no choice as to whether or not to replace the tariffs. If the user does not replace the tariffs, he cannot frank mail items anymore.

On the other hand, in the unique combination of claim 5, when the date of application of the new tariffs is reached, as in the prior art, these new tariffs are downloaded in the meter, but in contradistinction with Dlugos, the new tariffs do not replace the old tariffs.

In the Advisory Action dated November 8, 2010, the Examiner cited Markl (U.S. 5,710,706) as support for the Officially Noticed position, specifically pointing to column 1, lines 20-33 (see page 2 of Advisory Action). However, this disclosure of Markl describes that a new rate table cannot be installed prior to the effective date of the rates in the new table, which causes

a risk that out-of-date postal information may be installed in the postal scale unless the new table can be installed on the effective date of the new table.

Thus, if Markl discloses the use of an out of date rate table, it is only a result of a lack of a new table being installed and is described as a “risk,” i.e., this is not desirable. Thus, it would not have been obvious to have modified Baum, Boothby, and Dlugos based on the fact that it is known that an out of date table of rates may be undesirably applied only if a new rate table has not been installed as of the effective date of the new table. The combination of Baum, Boothby, and Dlugos includes a new rate that has been installed, and therefore, the out of date table would not continue to be used even after the effective date of the new table.

Accordingly, the combined teachings of Baum, Boothby, Dlugos, and Markl would not allow the user to decide whether to apply an old tariff or a new tariff when the old tariff is out of date.

Thus, it is respectfully submitted that the combination of claim 5 is patentable over the cited art at least because none of the cited art disclose or suggest “when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date.” Accordingly, Applicant submits that the rejection of claim 1 is in error for failure to establish a *prima facie* case of unpatentability, and should be reversed.

2. Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby, Dlugos, and Official Notice, and further in view of Eckert (US 4,516,014).

Eckert does not remedy the deficiencies of the basic combination to Baum, Boothby, the Official Notice and Dlugos because Eckert does not disclose or suggest franking with current postal data even though the date of application of the current postal data is out of date. Therefore, claim 8 is also allowable over the applied references.

3. Claims 1-3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby and Dlugos.

Independent claim 1 recites features that are similar to claim 5. Specifically, Claim 1 recites, among other features, “a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date.”

Accordingly, insofar as claim 1 is similar to claim 5, claim 1 is patentable over the cited references for at least the same reasons discussed, *supra*, relating to independent claim 5.

Furthermore, it is respectfully submitted that claim 1 is also patentable over the combined teachings of Baum, Boothby, and Dlugos because it would not have been obvious to have combined these references to arrive at the claimed invention, in which a comparing means compares one by one postal data in a first table with postal data in a second table.

In the invention of claim 1, by comparing the postal data one-by-one, the user may choose to replace an old tariff with a new tariff without necessarily replacing the entire table.

The Examiner alleges that although Baum does not disclose a comparing means for comparing one by one postal data in a first table with corresponding postal data in a second table, that Boothby discloses the one-by-one comparing and that it would have been obvious to have used this technique in Baum to yield predictable results (Final Office Action dated April 28, 2010, page 6).

However, the reason why Boothby compares the data records one by one is because the data records of the first “table,” e.g., a handheld computer, and the data records of the second “table,” e.g., a desktop computer, are each independently updated (see column 1, lines 16-17). That is, each table must be reconciled with the other table. In the updating of postal tariffs in general, on the other hand, the updating occurs in one direction, i.e., the new tariffs replace the old tariffs. Therefore, such one-by-one comparison from Boothby would not be necessary in Baum and in fact would appear to be more complex than the comparison of release dates performed in Baum. Thus, the combination of the cited references does not allow the user to have a choice of updating one tariff in a table of tariffs.

In the Advisory Action, the Examiner responded that additional advantages which would naturally flow from the suggestion of the prior art cannot be the basis of patentability. It is noted that the Examiner may not have understood the Applicants’ argument. Applicants had argued that the motivation for providing this feature in Boothby is not necessary in Baum, the primary reference. Consequently, it would not have been obvious to have modified Baum based on Boothby, irrespective of any additional advantages that result from such a hypothetical combination.

Accordingly, the rejection of claim 1 is in error because it would not have been obvious to have modified Baum based on Boothby as proposed by the Examiner.

Therefore, Claims 2, 3, 6, 7, 9, and 10 are allowable because of their dependency from Claims 1 and 5.

4. Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby and Dlugos and further in view of Thiel (US 6,321,214).

Claim 4 is allowable because Thiel fails to remedy the deficiencies of Baum, Boothby, and Dlugos in that Thiel does not disclose franking a mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date. Nor does not Thiel disclose or suggest comparing the postal data one-by-one.

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VIII. CONCLUSION

The statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) is being remitted. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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23373

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Date: December 8, 2010

CLAIMS APPENDIX

CLAIMS 1-10 ON APPEAL:

1. Device alerting to the expiration of tariffs for a franking system, comprising:
a random access memory (RAM) for recording postal data including:
a first table of postal tariffs relative to postal products and services, said first table of tariffs comprising postal tariffs applicable before a date of application,
a second table of postal tariffs relative to postal products and services, said second table of tariffs comprising postal tariffs applicable after said date of application; and
a processing unit comprising comparing means for comparing one by one postal data in said first table of postal tariffs with corresponding postal data in said second table of postal tariffs,
wherein said processing unit further comprises:
means for emitting to the operator of the franking system a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed, and
means for receiving a decision of the operator whether to replace the postal tariffs of the first table with the postal tariffs of the second table, for updating the postal tariffs at the operator's request,

the device further comprising a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date.

2. The device of Claim 1, wherein said second table of postal tariffs is loaded in the franking system at a periodicity defined by the Postal Service.

3. The device of Claim 1, wherein said second table of postal tariffs is loaded in the franking system from a remote resetting centre.

4. The device of Claim 1, wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded.

5. Process for alerting to the expiration of tariffs for a franking system comprising a display, a keyboard, a random access memory (RAM) for recording postal data and a processing unit for updating these postal data, said process comprising the following steps:

at a time of franking, when a date of application of new postal data previously loaded in the RAM of the franking system is identical to or earlier than a franking date of a mail item to be franked desired by an operator of the franking system,

comparing by the processing unit of the franking system current postal data of the mail item to be franked and present in the RAM one by one with corresponding new postal data to determine whether there is a change in the current postal data;

when it has been determined that the current postal data has changed, displaying a message on the display of the franking system alerting the operator to the expiration of tariffs;

receiving on the keyboard a decision of the operator whether to replace the current postal data with the new postal data; and

when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date.

6. The process of Claim 5, wherein the new postal data are stored at the location of the current postal data when the operator has accepted the updating of the current postal data.

7. The process of Claim 6, wherein the current postal data are stored in a blank part of the RAM, to be kept for control purposes.

8. The process of Claim 5, wherein the emission of the message alerting to the expiration of tariffs is inhibited by the operator except for the first such message after the franking system has been put into operation.

9. The process of Claim 5, wherein the postal data comprise postal tariffs.
10. The process of Claim 5, wherein the postal data comprise postal products and services.

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EVIDENCE APPENDIX

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

None

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RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

None